

**REMARKS/ARGUMENTS**

Applicant has reviewed the detailed office action mailed 09/29/2003 (paper no. 18) and thanks Examiner Marmor for his indication of allowable subject matter and review of the pending claims. Claims 1, 16, 18-24, 26, 31, 38 and 42-44 were rejected. Claims 2-15, 27, 29, 30, 32, 33, 39 and 46-84 were withdrawn. In this amendment, no claims have been cancelled. Claims 19, 24, 34-35 and 41-43 have been amended; however, no new matter has been added. Thus, claims 1-84 are pending in this application. Applicants request reconsideration of the pending claims in view of the above amendments and the following remarks.

**Oath/Declaration**

Applicants hereby submit a newly executed oath and declaration to replace the oath and declaration originally submitted with this application.

**Information Disclosure Statement**

Applicants include herewith a Supplemental Information Disclosure re-submitting the reference entitled "Probe Reduces Breast Biopsy Trauma," which complies with 37 CFR 1.97, 1.98 and MPEP §609.

**Drawings**

The drawings were objected to by the Examiner for failing to comply with 37 CFR 1.18(p)(5) because the reference numeral "65" shown in Figure 3A is not mentioned in the written description. Applicants submit herewith a set of corrected drawings, which remove reference numeral "65" from Figure 3A. While only Figure 3A of the drawings has been amended, Applicants have also submitted replacements sheets including those figures that were not amended for convenience.

**Specification**

The Examiner objected to the abstract of the disclosure because among other reasons, it exceeded the 150 word limit. Applicants have amended the specification to conform with U.S. Patent Office practice and procedure.

In addition, Applicants have amended various paragraphs of the specification, as recommended by the Examiner, to correct a number of informalities. No new matter has been added to the specification.

### **Claim Objections**

The Examiner objected to claims 19, 24, 34-35, and 41-43 for several informalities. Applicants have amended claims 19, 24, 34-35, and 41-43 to correct the informalities noted by the Examiner.

### **Claim Rejections – 35 USC §112**

Claims 42-44 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. More particularly, claim 42 was rejected because there is insufficient antecedent basis for the claim element “said hollow axle” in line 6. Applicants have amended claim 42 to recite “said tubular axle”, support for which is found in claims 40 and 41 from which claim 42 depends. In light of this amendment, Applicants respectfully request that the rejection of claims 42-44 under 35 U.S.C. §112, second paragraph, be withdrawn.

### **Claim Rejections – 35 USC §103**

A. Claims 1, 24, 26, 31 and 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hibner et al. (U.S. Patent No. 6,120,462) in view of Cucin (U.S. Patent No. 6,346,107). More particularly, the subject claims were rejected because “it would have been obvious to a person of ordinary skill in the art to modify Hibner to include the hydraulic motor disclosed in Cucin.” *See* Office Action, page 8. For at least the following reasons, Applicants respectfully disagree.

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish prima facie obviousness as follows: “To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be

a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Here, a prime facie case for obviousness has not been set forth in the first Office Action for at least two reasons: (1) Hibner and Cucin fail to teach or suggest each of the limitations recited in the claims; and (2) Hibner and Cucin teach away from their combination.

Regarding claim 1 as filed, the Hibner and Cucin references, either alone or in combination, fail to teach or suggest each limitation of the claimed invention. More particularly, Hibner fails to teach or suggest a hydraulic *reciprocating* motor operably coupled to an inner cannula to translate the inner cannula within an outer cannula. In contrast to the claimed invention, Hibner discloses a biopsy instrument that includes an inner cannula driven by an electrical rotary motor (340), not a reciprocating motor as claimed by the Applicants. In fact, Hibner also utilizes an electric rotary motor (338) to drive rotation of the inner cannula. Hibner uses rotary motors for both translating and rotating the inner cannula because the motors are located remotely from the handpiece (251) and drive movement of rotatable shafts 264 and 266. The following is an excerpt from Hibner describing the function of the two electric rotary motors:

"Rotation motor 338 and translation motor 340 transmit *rotational* power to switchboard-modified holster 251 via first and second rotatable shafts, 264 and 266, respectively." Hibner, Col. 14, lines 41-44 (emphasis added).

Therefore, not only does Hibner fail to teach or suggest use of a hydraulic motor, it also fails to disclose the use of a *reciprocating* motor to translate the inner cannula.

Further, the cited references teach away from their combination because modifying Hibner with Cucin would render the Hibner biopsy instrument inoperable. More particularly, Hibner requires two *rotary* motors to drive movement of rotatable shafts 264 and 266. However, Cucin discloses a pneumatic *reciprocating* motor, not a rotary motor as required by Hibner. In other words, replacing the electric rotary motors required in the Hibner instrument with the reciprocating motor disclosed in Cucin would render the Hibner device inoperable.

B. Claims 16 and 18-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hibner et al. in view of Cucin as applied to claim 1 above, and further in view of Ritchart et al. (U.S. Patent No. 5,649,547). Applicants respectfully traverse the rejection.

Regarding claims 16 and 18-23, the arguments above in section A are also applicable here. Additionally, regarding claims 18-23, the Hibner reference explicitly teaches away from a handpiece that supports the first and second electric rotary motors (338 and 340). Particularly, Hibner teaches positioning the two electric rotary motors (338 and 340) remotely from the holster 140 to make the handpiece lightweight and ergonomically shaped.

**Allowable Subject Matter**

Claims 17, 25, 28, 34-37, 40, 41 and 45 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Since claim 1 is allowable in light of the cited references, Applicants have not rewritten claims 17, 25, 28, 34-37, 40, 41 and 45 in independent form.

Claims 42-44 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Since claim 1 is allowable in light of the cited references, Applicants have not rewritten claims 42-44 in independent form.

**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65937-0002 from which the undersigned is authorized to draw.

Dated: 1/29/04

Respectfully submitted,

By   
Bradley J. Dieckrich

Registration No.: 47,526

RADER, FISHMAN & GRAUER PLLC  
39533 Woodward Avenue, Suite 140  
Bloomfield Hills, Michigan 48304  
(248) 594-0651  
Attorney for Applicant

Attachments

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**REPLACEMENT SHEETS**